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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/033,909	03/03/1998	YUZO KIKUCHI	KIKUCHI=2	2662

1444 7590 06/20/2002

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EXAMINER

WACHTEL, ALEXIS A

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 06/20/2002

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/033,909

Applicant(s)

KIKUCHI, YUZO

Examiner

Alexis Wachtel

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 52-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Detailed Action

Response to Amendment

1. Applicant's amendment and accompanying Remarks filed on 4-4-2002 have been entered and carefully considered.

The amendment is sufficient to overcome the anticipation and obviousness rejections of claims 35-51. Claims 35-51 have been cancelled and new claims 52-69 have been submitted for consideration.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 52 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 52 as written contains new subject matter unsupported by the specification. No embodiment shows a first substrate with a welding fabric attached thereon, wherein the welding fabric (has a **welding portion containing auxiliary fixing means**) is attached to a second substrate with a welding fabric attached thereon wherein the welding fabric has a first and second welding portion and a first and second fixing portion.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 52-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. With regards to claim 52, Applicant does not clearly describe what is meant by phrase "a material comprising... a welding portion and a fixing portion...welding portion contains auxiliary means comprising holes bored into the fixing portion". How can the welding portion have auxiliary fixing means if holes are bored into the fixing portion, which is identified in claim 52 as being distinct from the welding portion? In addition, Applicant does not clearly describe what is meant by phrase "a second substrate... wherein said second substrate comprises a welding fabric welded to a second substrate, wherein said welding fabric comprises a second welding portion and a second fixing portion". What is the second substrate? Is the second substrate said welding fabric? Is said welding fabric which comprises a second welding portion and a second fixing portion distinct from the welding fabric having a first welding portion and a first fixing portion? Additionally, Applicant does not clearly describe what is meant by phrase "said second fixing portion is provided with second auxiliary fixing means". In what way is the second fixing portion provided with second auxiliary fixing means? Are fixing means part of said second fixing portion or are they separate? Are second auxiliary fixing means structurally attached to said second fixing portion. Additionally, claim 52 recites the limitation "fixing unit". There is insufficient antecedent basis for this limitation in the claim. Claim 52 as written is so incomprehensible as to preclude examination, therefore claims 52-59 will not be additionally treated on the merits.

7. With regards to claim 68, Applicant does not clearly describe what is meant by phrase "a material comprising... a welding portion and a fixing portion...welding portion contains auxiliary means comprising holes bored into the fixing portion". How can the welding portion have auxiliary fixing means if holes are bored into the fixing portion, which is identified in claim 68 as being distinct from the welding portion? Claim 68 as written is so incomprehensible as to preclude examination, therefore claim 68 will not be additionally treated on the merits.

8. With regards to claim 60, Applicant does not clearly describe what is meant by phrase "a second substrate... wherein said second substrate comprises a second welding fabric welded to a second substrate, wherein said second welding fabric comprises a second welding portion and a second fixing portion". What is the second substrate? Is the second substrate the second welding fabric? Examiner assumes that said second substrate is not a welding fabric, but whose structure (second substrate) has a second welding fabric affixed thereon.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 60-67,69 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,286,77 to Oellerking in view of WO 97/49541 to Christensen et al.

Oellerking discloses a fabric comprising a welding portion and a fixing portion. The welding portion comprises a weldable plastic material. The fabric may also comprise a fixing portion, (i.e., a non-coated portion). Since a fabric necessarily comprises fibers and since the weldable material comprises warp fibers and since the weldable material comprises a thermoplastic coating on a fabric, Oellerking inherently teaches that the welding portion comprises warp fibers which are coated with a thermoplastic material (Fig. 1, Col 2, lines 38-55, Col 3, lines 3-15).

Oellerking differs from the claimed invention because Oellerking does not specifically teach applying the welding portion so that it is in the middle of the fixing portion, so that the two welding portions are attached to the middle of said fixing portion, so that two welding portions are branched from one edge of said fixing portions. However, since Oellerking does teach that weldable coating is applied to facilitate bonding the fabric to a substrate, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the weldable coating to the fabric in the pattern which would have most facilitated the bonding of the fabric to a substrate (Fig. 1, Col 2, lines 38-55, Col 3, lines 3-15).

Oellerking also differs from the claimed invention because Oellerking does not teach incorporating auxiliary fixing means into the fixing portion (i.e, the non-coated portion) of the welding fabric. Christensen teaches that providing auxiliary fixing means such as stitching in the portion of a welding fabric outside of the welded portion enhances the overall strength of the bond. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included auxiliary

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fixing means in the fixing portion of the welding fabric of Oellerking such as stitching the welding fabric to the substrate at a location near by outside the welded regions. One of ordinary skill in the art would have been motivated to include auxiliary fixing means by the expectation that such auxiliary fixing means would enhance the overall strength of the patch.

Oellerking-in view of Christensen as set forth above fails to teach a welding fabric wherein said welding portion is in the middle portion of said welding fabric. However, since Oellerking does teach that the weldable coating is applied to facilitate bonding the fabric to a substrate, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the weldable coating to the fabric in the pattern which would have most facilitated the bonding of the fabric to a substrate.

With regard to the limitation that the material comprising the welding fabric and a first substrate are fixed to a second substrate which comprises a second welding fabric that has a second welding portion and a second fixing portion, since Oellerking teaches bonding a first welding fabric to a first substrate such as a tarp and since it is well known conventionally to secure tarps to other substrates such as columns, stakes, building etc., it would have been obvious to one of ordinary skill in the art at the time the invention was made to have secured the first material of Oellerking (which would comprise the welding fabric and the tarp) to a second substrate such as building, column, stake, fence, etc (with the aid of a second welding fabric welded thereon so as to aid in unifying contact between said first and second substrates). Also, depending upon where the defect in the tarp of Oellerking was located, it would have been

obvious to have secured the welding fabric and tarp by means of auxiliary fixing means which were located in the non-coated portion of the first welding fabric to the second welding fabric's auxiliary means.

With regards to the limitations that the fixing portion comprises holes bored in the fixing portion or that the fixing portion comprises straps provided in the fixing portion, since Oellerking teaches that the welding fabric is suitable for use in repairing covers for containers, lorries, etc., it would have been obvious to form holes in or attach straps to the fixing portion in order to enable the welded material, (i.e., the patch and cover), to be joined or held on the materials which the welded material is covering. For example, it is known to provide holes or provide straps of fabrics which are used as tarpaulins or covers so that the fabrics can be tied to whatever the fabric is covering. Thus, if a patch was made, which corresponds to the welding fabric claimed), it would have been obvious to have similarly incorporated means for tying or otherwise securing the welded material to whatever the welded material was going to cover, especially if the patch were going to be welded to the fabric in an area which already comprised such holes and/or straps, since the patch would otherwise cover the holes and/or straps.

Conclusion

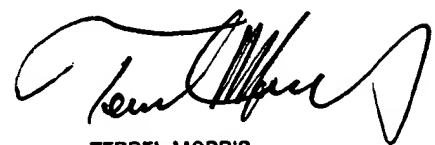
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Alex Wachtel, whose number is (703)-306-0320. The Examiner can normally be reached Mondays-Fridays from 10:30am to 6:30pm.

If attempts to reach the Examiner by telephone are unsuccessful and the matter is urgent, the Examiner's supervisor, Mr. Terrel Morris, can be reached at (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



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